

REMARKS

Claims 1-49 remain pending in the application, unchanged.

All of the claims stand rejected as obvious over Barton (5,646,997) in view of Seth-Smith (4,890,319) – some in view of additional art.

As explained earlier, Barton has limited utility. It cannot be used to reliably encode pixel image data that is thereafter JPEG processed. It cannot be used to reliably encode image data that is thereafter printed on paper (a process that significantly alters many bits of the original image representation). It cannot be used to reliably encode image data that is thereafter exposed onto emulsion film. Etc., etc. His arrangement requires that the encoded information be kept in its originally encoded, pristine digital form.

The Action cites Seth-Smith to cure certain of these deficiencies.

Seth-Smith relates to subscription television systems. As noted at col. 14, lines 61-68, his system represents a single bit of flag information as an eight bit byte, to render the detection and decoding process more robust to reduce overall system errors.

Seth-Smith conveys his flag bytes as teletext data, *in the vertical blanking interval of a video signal* (e.g., col. 7, lines 23-29).

Seth-Smith's teachings cannot be combined with Barton's image encoding teachings to yield the claimed arrangements. For example, claim 18 is directed to "a method of encoding a photograph." A photograph doesn't have a vertical blanking interval through which Seth-Smith teaches robust communications can occur.

Accordingly, even if Barton and Seth-Smith were attempted to be combined by an artisan, the arrangement of claim 18 (nor the other claims) could not result. Seth-Smith simply has no teaching that would enable an artisan to modify Barton so as to yield the claimed arrangements.

In response to such arguments, the Office has previously argued:

Regarding Applicant's argument that Seth-Smith cannot be combined with Barton because Seth-Smith is related to teletext data, the Seth-Smith reference is merely

relied upon for its teaching of robust encoding and not the specifics of the data being encoded.¹

Applicants respectfully submit that Seth-Smith's teaching of robust encoding does not aid the rejection unless an artisan is informed how to implement robust encoding in Barton. Seth-Smith has no teaching or suggestion on this point.

There are various requisites to an obviousness rejection. One is that the teachings of the art – if combined – must yield the claimed combination. In the present case, an artisan could not produce the claimed combination by following the teachings of Seth-Smith and trying to apply them to Barton.

The pending rejections have many other shortcomings. But the one just-noted is so fundamental that it undercuts all of the rejections (each of which is predicated on Barton + Seth-Smith). Because of this failure, none of the rejections meets the Office's burden of showing *prima facie* obviousness. Accordingly, applicants do not belabor this response by further remarks on the rejections, the art, or the claims.

The Examiner is requested to discuss this point with Primary Examiner Smithers (with whom the present assignee Digimarc has worked on various interference matters), so that an unnecessary appeal might be avoided.

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Respectfully submitted,

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¹ July 7, 2005, Action, page 17 (emphasis added).